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10/777,478

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Nicola Funnell

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EXAMINER

MANOHARAN, MUTHUSWAMY GANAPATHY

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/777,478

Applicant(s)

FUNNELL, NICOLA

Examiner

Muthuswamy G. Manoharan

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,6 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter (**"where the associated system information for each of the same information element is different"** (claims 1 and 6) and **"that also have different associated system information"** (claim 7)) which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The dependent claims 2-5 are also rejected, since they depend on the rejected claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-4 and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by 3GPP (TS 25.331 v3.16.0 (2003-9)) (hereinafter Reference (A)).**

Regarding claim 1, Reference (A) teaches a method for handling system information in a mobile telecommunications system, the system comprising a network of a plurality of cells and at least one user equipment device, the method comprising, in the user equipment device:

receiving a system information block of type 11 ("system Information Block type 12" in Section 8.1.1.6.11) relating to idle and connected mode (line 2, 14, and 22 in Section 8.1.1.6.11) and a system information block of type 12 ("system Information Block type 12" in Section 8.1.1.6.12) relating to connected mode (line 1 in Section 8.1.1.6.12), each of the system information blocks of type 11 and 12 including at least one system information block information element (lines 29-31 in Section 8.1.1.6.11) the information element related to a cell information list (lines 7-9, lines 24-28 and lines 31-32 in Section 8.1.1.6.11; lines 14-53 in Section 8.1.1.6.12) and having associated system information ("measurement identity", line 20 in Section 8.1.1.6.11 );

identifying a same information element from each of the system information block of type 11 and the system information block of type 12 where each of the same information elements is related to at least one cell information list where the associated system information for each of the same information element is different (lines 49-50 in Section 8.1.1.6.11); and

applying the different system information associated with the identified same information elements by applying the system information associated with the information

element from block type 11 and the applying the system information associated with the information element from block type 12 ( Section 8.1.1.4, lines 1-3; Section 8.5.23, lines 6-15).

Regarding claim 2, Reference (A) teaches a method according to claim 1, wherein the system information block information element is selected from the following system information block information elements; an information element relating to an intra-frequency cell information list (Section 10.3.7.33), an information element relating to an inter-frequency cell information list (Section 10.3.7.13) and an information element relating to an inter-Radio Access network (RAT) cell information list (Section 10.3.7.23).

Regarding claim 3, Reference (A) teaches a method according to claim 1 wherein the system information block information element is any of the following: "intra-frequency cell info list", "inter-frequency cell info list" and "Inter-RAT cell info list" (lines 28-30 in Section 8.1.1.6.11 and lines 8-10 in section 8.1.1.6.12).

Regarding claim 4, Reference (A) teaches user equipment device configurable for use in a mobile telecommunications system, the system comprising a network of a plurality of cells ("cells" on Page 56, line 6) and at least one user equipment device ("UE" on Page 56, line 8), the user equipment device being arranged to carry out the steps of claim 1.

Regarding claim 6, Reference (A) teaches a method for handling system information in a user equipment device, the device enableable for use in a UMTS mobile telecommunications system, the system comprising a network of a plurality of cells and at least one user equipment device, the method comprising:

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receiving a system information block of type 11 ("system Information Block type 12" in Section 8.1.1.6.11) and a system information block of type 12 ("system Information Block type 12" in Section 8.1.1.6.12), the system information block of type 11 relating to idle and connected mode (line 2, 14, and 22 in Section 8.1.1.6.11) and the system information block of type 12 relating to connected mode (line 1 in Section 8.1.1.6.12), each of the system information blocks (lines 7-9, lines 24-28 and lines 31-32 in Section 8.1.1.6.11; lines 14-53 in Section 8.1.1.6.12) including at least one system information block information element, the information element related to a cell information list (lines 29-31 in Section 8.1.1.6.11) and having associated system information ("measurement identity", line 20 in Section 8.1.1.6.11);

identifying a same information element in the system information block of type 11 and the system information block of type 12 where each of the same information elements relates to at least one cell information list and where the associated system information for each of the same information elements is different (lines 49-50 in Section 8.1.1.6.11); and

applying the system information associated with the identified same information elements by applying the system information associated with the information element from block type 11 and then applying the system information associated with the information element from block type 12 (Section 8.1.1.4, lines 1-3; Section 8.5.23, lines 6-15).

Regarding claim 7, Reference (A) teaches a method for handling system information in a user equipment device, the device enableable for use in a UMTS mobile telecommunications system, the system comprising a network of a plurality of cells:

Receiving at least one each of System information Block (SIB) 11 and SIB 12 each with one or more information elements (IEs) relating to any of "intra-frequency cell info list", "inter-frequency cell info list" and "Inter-frequency cell info list" (lines 28-30 in Section 8.1.1.6.11 and lines 8-10 in section 8.1.1.6.12), identifying a same IE in both SIB 11 and SIB 12 that also have different associated system information, applying the system information associated with the system information block information element in SIB 11 and the applying the system information associated with 20 the corresponding system information block information element in SIB 12 (Section 8.1.1.4, lines 1-3; Section 8.5.23, lines 6-15).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reference (A) in view of Laitinen et al. (hereinafter Laitinen) (US 6765891).**

Regarding claim 5, Reference (A) teaches all the particulars of the claim 1, except a computer program product comprising program code means stored on a

computer readable medium when the program is run on a computer. However, Laitinen teaches in analogous art, (Col. 4, lines 29-40) computer program product comprising program code means stored on a computer readable medium when the program is run on a computer. Therefore, it would be obvious to one of ordinary skill in the art at the time invention to implement the method using a computer program product comprising program code means stored on a computer readable medium when the program is run on a computer. This modification provides a method of implementation of Radio Resource Control protocol for the UE-UTRAN radio interface.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-7 have been but they are related to the limitations currently amended.

Applicant argues that (Page 6), "3GPP does not disclose the operation of identifying two same IEs one in type 11 SIB and one in a type 12 SIB **with different associated system information.**

Also, there is no disclosure of "different system information received in different SIBs but contained in the same IE" by the specification. However, Applicant agrees that system information is reassembled by the UE. Further 3GPP teaches in section 8.1.1.6.12 that **the missing information elements from SIB 12 are filled with SIB 11 elements** and also teaches, "after reception of System information block type 11" (section 8.1.1.6.12, line 2). Therefore, UE is reading SIB 12 after reception of system information block type 11.



Since the missing information elements from SIB 12 are filled with elements from SIB 11, one cannot say that information stored in UE is SIB 12 or SIB 11. SIB 12 is gap filled with SIB 11?. Therefore, read and act on SIB 12 as indicated in 8.1.1.6.12 could mean applying system information 12, with missing elements from SIB11. Also, if the system information is same in both SIB 11 and SIB 12 then there is no difference as which one is applied first. UE is putting all the SIB information into one single information block which contains all the information elements needed and applying the system information.

Further, Applicant did not show wherein the specification the limitations **"where the associated system information for each of the same information element is different"** (claims 1 and 6) and **"that also have different associated system information"** (claim 7)) are being taught.

The above teachings are not described in the specification of the applicant in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Muthuswamy G. Manoharan whose telephone number is 571-272-5515. The examiner can normally be reached on 7:00AM-2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eng George can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
GEORGE ENG  
SUPERVISORY PATENT EXAMINER